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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------------|------------------|
| 09/742,679      | 12/20/2000  | Robert A. Luciano    | 732.462<br>SDG.UA-Maintainin | 9914             |

7590 04/09/2003

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EXAMINER

CHERUBIN, YVESTE GILBERTE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3713

DATE MAILED: 04/09/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/742,679

Applicant(s)

LUCIANO ET AL. *oh*

Examiner

Yveste G. Cherubin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 92-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 92-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).-----
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. The request filed on March 25, 2003 for a RCE under 37 CFR 1.53(d) based on parent Application No. 09/742,679 is acceptable and a CPA has been established.

An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- a. Claims 92-93, 97-98, 102-103, are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo (US Patent No. 4,752,068) in view of Stockdale et al. (US Patent No. 6,2514,014) and further in view of Burns et al. (US Patent No. 6,048,269) (all of record).

As per claims 92, 97, 102-103, Endo discloses a video gaming machine capable of storing the status of a gaming session at a time of interruption or suspension and restore the session at a later time from where it was interrupted or suspended (see abstract). At time of suspension, Endo discloses using a password, which is displayed to player, and which later can be used along with the player identification to restore the game at the state of interruption or suspension, 3:22-24. Endo fails to have a printer connected to his system. Stockdale on the other hand discloses a gaming machine such as slot machine, video slot machine, 2:58-60, having a plurality of peripheral

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devices such as lights (16), printers (238), coin hoppers, bill validators, ticket readers, card readers, speakers (10, 12, 14), to name a few, connected thereto, 2:60-65. Stockdale further discloses that many of these devices are built into the gaming machine or grouped together in a separate box commonly called a top box (6), 5:37-6:40-43. The ticket printer (18) is able to print bar-coded tickets 5:40-41, and those tickets (20) can later be used for food, merchandise, or games, 6:6-11. Stockdale fails to elaborate on what he means by *using the tickets for games*. However, it would have been obvious at the time the invention was made to modify Endo's type system and include the ticket printer and the ticket reader as taught by Stockdale into Endo's system in order to provide printed ticket to players. Such modification would prevent players from having to memorize a bunch of numbers, which have no personal meaning to players and which could be easily forgotten. As for having those tickets printed with indicia identifying the game state, it would have been obvious. In addition, a patent to Burns is being added to show that one can print any type of information on a printed card or ticket (see Burns, Figs 2-4). It would have been obvious to have related indicia printed on those game tickets for clarification purposes. As per claim 98, it recites the limitations of claim 92 with the exception of the primary and secondary games comprising in a game. Refer to claim 92 above for rejection. In addition, as stated above, Stockdale teaches slot machines, which are known for comprising game, which includes primary and secondary or bonus game. Endo, on the other hand, discloses that regardless of the progress of a game, the game is interrupted whenever one playing time has passed. Reading this passage, it's obvious that a device could be configured

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to interrupt or suspend a gaming session at any stage of the game, meaning whether it is during primary or secondary or bonus stage of the game. One of skill in the art would have been motivated to have the system configured as such in order to give a feeling of control to players. As for having printed ticket that has indicia identifying a player's state of the secondary game, it would have been obvious.

b. Claims 94, 96, 99, 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo in view of Stockdale et al. and Burns as applied to claims 92-93, 97-98, 102-103 above, and further in view of Kelly et al. (US Patent No. 6,015,344).

As per claims 94, 96, 99, 101, Endo in view of Stockdale and Burns disclose the claimed invention as substantially as explained above. Endo in view of Stockdale and Burns fail to disclose a secondary game requiring a collection of earned points to win a bonus prize. Kelly teaches scoring and collecting points for awards redemption, 8:3-7, 39-46. It would have been obvious to include the point collection system of Kelly into the Endo in view of Stockdale and Burns type system in order to allow players more chance at winning. Having the tickets including indicia further identifying the player's earned secondary points would have been a matter of design choice. One of ordinary skill in the art would be motivated to include as many types of indicia as possible on a printed ticket in order to make it as clear as possible, so there would be no confusion in case a player accumulates other tickets from other gaming machines.

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c. Claims 95, 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo in view of Stockdale et al. and Burns as applied to claims 92-93, 97-98, 102-103 above, and further in view of Yoseloff (US Patent No. 6,312,334).

As per claims 95, 100, Endo in view of Stockdale and Burns disclose the claimed invention as substantially as explained above. Endo in view of Stockdale and Burns fail to disclose a secondary game requiring a collection of game pieces to win a bonus prize. Yoseloff discloses a wagering game wherein when the player wins a certain number of games or achieves a predetermined skill level in a game, a second screen or secondary game will appear which either permits the player to play the same game at a higher skill level or allows the player to engage in a special feature of that game such as collect additional game pieces or 'lives' in Mario Brothers.RTM to win a bonus prize, 1:66-67, 2:1-28; 6:1-25. Having the tickets including indicia further identifying the player's earned game pieces would have been a matter of design choice. One of ordinary skill in the art would be motivated to include as many types of indicia as possible on a printed ticket in order to make it as clear as possible, so there would be no confusion in case a player accumulates other tickets from other gaming machines.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 92-103 have been considered but they are not persuasive. On pages 7-8, Applicants argue each reference individually.

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Applicants cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combination of references. In re Keller, 208 USPQ 871 (CCPA 1981). It is true that Endo's system is being implemented in a video gaming environment where no wagers are involved but the Applicants seem to ignore that Endo is being combined with Stockdale which teaches a system being implemented in slot or video slot devices which allow players to wager and which are usually located and operated in a casino gambling environment. The Examiner contends that the references to Endo, Stockdale and Burns are all being implemented in gaming environment, which makes the combination proper. Although Endo teaches a video gaming environment, it's obvious that the game state saving feature could be implemented in the casino environment as well. See rejection above.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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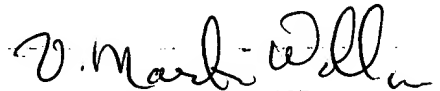
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

April 4, 2003

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VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER  
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